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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 12

Application Number: 09/732,120
Filing Date: December 07, 2000
Appellant(s): RADOSAVLJEVIC & VOUGHT

Daniel P. Malley
Wall Marjma & Bilinski
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 6, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest, Pass & Seymour, Inc., is contained in the brief.

(2) *Related Appeals and Interferences*

A statement indicating that there are no related appeals or interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of the invention is substantially correct. However, contrary to applicant's statements, there is no disclosure (or claim) that the "resistor-capacitor (RC) circuit is also mounted on circuit board 15." Nor is there any disclosure that "the RC network and all other components are interconnected by electrical traces disposed in and on the circuit board 15."

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that all of the claims stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5365028	Takano	11-1994
5296103	Hanna	3-1994

(10) Grounds of Rejection

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Takano '028. This slide switch comprises a circuit board 10d with a housing 10a connected thereto, a glider 12, a contact spring 16 with a projection 16a and a plurality of contacts 22b on the circuit board. The contacts are spaced so that the projection forms a detent therewith.

Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takano '028 in view of Hanna. The slide switch of Hanna teaches a multi-pole, multi-throw switch that is similar to that of Takano. It includes a second row and a second contact spring to better handle the desired load. For the same reason, a second row and contact spring would have been obvious on the switch of Takano. Hanna also teaches the use of additional contacts in the rows in order to have more speeds for the fan it is operating. For the same reason, it would have been obvious to have additional contacts and positions on the switch of Takano in order to accommodate additional speeds thereon. In regard to claims 5 and 6, Hanna teaches the use of capacitors arranged similar to that claimed in order to accomplish the variety of speeds. For the same reason, it would have been obvious to include capacitors to adjust the result of the output of the positions of the switch of Takano.

(11) Response to Arguments

Appellant states that the examiner “misidentifies bottom plate 10d by referring to it as a circuit board” (bottom of page 4 of the Brief). However, the reference to member 10d as a circuit board is not a misidentification. The member is a board and it supports portions (i.e. contacts and leads) of a circuit. It is therefore a circuit board. It may not be the same type of circuit board intended by appellant, but it **does** meet the claimed limitations.

Appellant argues that since Takano does not call the structure a circuit board, then it cannot be one. This is merely a matter of semantics. The name that one patentee chooses to give a structure does not eliminate other names for the structure.

Appellant argues (page 5 of Brief) that member 10d of Takano is not a circuit board because it does not include any electrical traces and does not perform any of the functions normally associated with a circuit board. However, the board does include traces 22 thereon (see Fig. 6) between the contacts 22b and the leads that extend away from the switch. Appellant does not indicate what functions are expected of a circuit board. However, from the present application, especially claim 1, it appears that appellant expects a circuit board to support a plurality of contacts and to be connected to the switch housing. As noted above the structure 10d of Takano supports contacts 22b. In addition, it is connected (via screws 10e) to the housing 10a (see Figs. 6 and 7).

Appellant further argues (bottom of page 6 of the Brief) that Takano lacks circuitry. However, a circuit is merely a means of transmitting electrical signals from one place to another. The strips 22 mentioned by appellant, the contacts 22b, etc. are all parts of a circuit.

Additionally, appellant states (page 7 of Brief) that Takano lacks “a plurality of contacts mounted on a circuit board” and a “glider housing for disposition on a circuit board.” The arguments to support these statements are based on the lack of a circuit board. As noted above, Takano does include a circuit board.

Appellant has not indicated any **claimed limitation** that is not met by the device shown by Takano.

In regard to the rejection of claims 3-6 under 35 U.S.C. 103(a), appellant argues that there is no suggestion to combine the references. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In the instant case, each of the features are well known. Their uses and advantages are well known and discussed by Hanna. As stated above, and in the original rejection, it would have been obvious to add the features of Hanna to the switch of Takano for the same reasons that they are used on the switch of Hanna. Contrary to appellant's assertion that the examiner "must point to where the prior art suggests the desirability" of combining the references, the motivation for combination may also be found in knowledge available to the general public.

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to appellant's suggestion that there is no reasonable expectation of success (page 10 of the Brief), it is noted that all of the features are well known. They are not very complicated and are well within the


Art Unit: 2833

understanding of even one of less than average skill in the art. There is no reason not to expect success in combining these features. Applicant has not shown that one of average skill in the art would have any difficulty combining the features. In addition, applicant is reminded that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

(12) Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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rsl


November 18, 2003

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